

REMARKS

Claims 8-34, 50-51, 53-92, 118-119, 178-182, and 185-195 were pending in the present application. By virtue of this response, claims 15 and 28 are cancelled; claims 8-11, 14, 16, 18, 20, 22-25, 27, 29, 31, 33, 80, 187, and 192 are amended; and new claims 196-207 are added. Support for new claims 196-207 is found, *inter alia*, in the specification on page 55, lines 20-24 and original claims 12, 18-20, 26, and 31-33. Accordingly, claims 8-14, 16-27, 29-34, 50, 51, 53-92, 118-119, 178-182, and 185-207 are currently under consideration.

Applicants respectfully note that the Examiner in the current Office Action indicates that claims 8-34, 50, 51, 53-92, 118, 119 and 159-162 are pending and under consideration. However, the Examiner stated in the previous Office Action (dated Dec. 16, 2003) that claims 8-34, 50, 51, 53-92, 118, 119, 159-162 and 178-194 were pending and were allowed. In the amendment filed on June 10, 2004, claims 159-162, 183 and 184 were cancelled, and new claim 195 was added. Applicants respectfully request clarification from the Examiner that claims 178-182 and 185-195 have been entered and considered.

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional application.

Supplemental Information Disclosure Statement

Applicants note that a Supplemental Information Disclosure Statement accompanies this amendment. Applicants respectfully request the Examiner consider the reference and initial the PTO/SB/08a/b form.

Applicants also note that Applicants have not received initialed PTO-1449 form submitted with Supplemental Information Disclosure Statement on January 17, 2003 and September 27, 2004. Applicants respectfully request the Examiner initial these two PTO-1449 forms.

Nonstatutory double patenting rejections

Claims 22-34, 118, 119 and 159-162 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 126, and 159-162 of allowed U.S. Patent Application No. 09/526,333 (now U.S. Patent No. 6,566,118). The Examiner states that Applicants have filed a terminal disclaimer, but there is no statement accompanying the terminal disclaimer that meets the requirement of 37 CFR §3.73(b).

Applicants respectfully note that a statement under 37 CFR §3.73(b) has been submitted with the terminal disclaimer over U.S. Patent No. 6,566,118 on June 10, 2004. A copy of the statement and the postcard is attached with this amendment. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Applicants also note that a terminal disclaimer over U.S. Application Ser. No. 10/020,482 with a statement under 37 CFR §3.73(b) was also submitted on June 10, 2004.

Claims objections

The Examiner has objected to claims 18, 20, 31 and 32 for the following informalities: POROS appears to be a trademarked name and the specific product it presents should be recited; the terms HS and SP should be spelled out the first time they are recited in the claims. The Examiner has requested Applicants to check the claims and determine if any other similar terms are used and make appropriate correction.

Without acquiescence to the objection and in the interest of expediting prosecution, Applicants respectfully note that claims 18, 31, 80, 187, and 192 have been amended to delete POROS 50 PI resin; and claims 20 and 33 have been amended to spell out the terms "HS" and "SP".

Applicants respectfully request that the objections to claims be withdrawn.

Claim rejections under 35 U.S.C. §112, second paragraph

Claims 8-34, 50, 51, 53-92, 118, 119, and 159-162 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claims 8 and 22 recite chromatographing the "same" lysate in each of the steps of chromatographing over two resins. The Examiner suggests that the claims be amended to recite an additional step that results in an enriched or purified lysate and then that lysate is used in part (b). The Examiner further states that steps in claims 8 and 22 do not have a required temporal order so that switching the order in the dependent claims does not further limit. The Examiner states that claims 13 and 14 are not clear as to where the step is inserted, and it is not clear whether step in claim 13 occurs prior to lysing and step in claim 14 occurs prior to (a). The Examiner also states claim 15 is not further limiting. The Examiner states that in claims 28 and 29 it is not clear at what point the added step is intended to be performed.

Without acquiescence to the rejections and in the interest of expediting prosecution, Applicants have amended claims 8, 14, 22, 27 and 29, and have cancelled claims 15 and 28 for clarification. Applicants respectfully note that claims 8 and 22 have been amended to clarify that the fraction collected from the chromatography in step (a) is used for chromatographing in step (b). Applicants respectfully submit claims 8 and 22 as amended have a temporal order so that switching the order in the dependent claims further limits the claims. Applicants also note that claims 14, 27 and 29 are amended to clarify when the added step is intended to be performed. Applicants respectfully submit that claims 8, 14, 22, 27, and 29 as amended are clear and definite.

Applicants respectfully submit that claim 13 is clear to one skilled in the art with respect to when the step is performed because the AAV producer cell lysate are generated from the producer cells.

Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.226272003310. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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